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FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

SAYALA, CHHAYA D

ART UNIT	PAPER NUMBER
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1781

NOTIFICATION DATE	DELIVERY MODE
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09/13/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nstacey@fulbright.com
twrye@fulbright.com
hoipdocket@fulbright.com

Office Action Summary	Application No. 10/540,094	Applicant(s) HALL, SIMON REGINALD	
	Examiner C. SAYALA	Art Unit 1781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8, 10, 11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8, 10, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 4, 3-8, 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not specifically state that "an excess quantity" was provided to the animal. Applicant is urged to point out where basis for this limitation is to be found in the specification. Upon applicant pointing out where this has been described, this rejection will be withdrawn. The standard for evaluating new matter in the claims is not whether the subject matter would be obvious to one skilled in the art from the specification as originally filed. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she

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was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 3-8, 10-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/97630 in view of Jewell et al. (US Patent 6410063) and further in view of Romsos et al. (JAVMA, vol. 182(1), pp. 41-43, 1983) and Wills, ("Adult Maintenance," BSAVA Manual of Companion Animal Nutrition & Feeding, Chapter 3; British Small Animal Veterinary Association 1996, pgs 44-46), Rice ("The Dog Handbook", pages 48-49, published by Barron's Educational Series, 1999) and JP 02238464.

WO '630 offers pet food compositions with differing macronutrient contents, one composition being higher in protein and another being higher in fat. See

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page 4. The patent also discloses a multipack for pets (page 6, line 20+) with different compositions, differing in protein and fat contents as shown on page 8. Note that example 1, protein up to 70% is disclosed as well as fat up to 90. The patent discloses varying carbohydrate contents at Example 3, and even though the patent discloses that the food contains carbohydrate (page 3, line 11+), it fails to disclose the amount specifically. The reference teaches compositions differing in fat content and protein content by 5%. See examples and page 4, last paragraph. Such disclosure renders obvious claims 3-5. With regard to claim 6 and claim 11, see page 5, lines 13-14 that discloses snacks such as cereal bars and page 6, line 21 to page 7, line 6, wherein it is disclosed that multi-packs can have individually packaged food packs.

Jewell et al. specifically teach a food composition for cats which includes carbohydrate in an amount 1-20%, protein 25-70% and fat 25-75%. The composition is said to help maintain the cat's health and induces a state of ketosis. Taken together with the above references, to incorporate these amounts for the carbohydrate as a macronutrient for the pet food and to provide varying amounts as for protein and fat would have been obvious to one of ordinary skill in the art at the time the invention was made i.e. to repeat the teachings of the WO patent for the third macronutrient would not have required more than ordinary skill. Jewell et al. teach their composition for cats, however, to use a similar composition for any of all the animals encompassed by the instant claims would have been obvious to one of ordinary skill in the art by optimizing the amounts of macronutrients for any particular animal. Although the reference teaches using these diets one per day and not all simultaneously, based on the

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following references, offering these foods simultaneously would have been beneficial and such a concept would have become immediately obvious to the practitioner.

In this regard, Romsos et al. disclose that animals such as rats and dogs are able to self-select their diet and are able to regulate their protein and energy intake by self-selection when allowed free-choice feeding. Rosmos discloses *simultaneously* offering 2 or 3 diets differing in protein for self-selection (see paragraph bridging pages 242 and 243). The dogs under this study were able to regulate their protein intake and establish a pattern in a week of the study. Rosmos states "It is well established that animals, including dogs, are able to regulate their intake of energy. When the energy density of the diet is lowered, dogs consume more food to maintain approximately the same energy intake". (Page 41). In order to "consume more food", it would necessarily mean that more food was offered, i.e. "an excess quantity". Rosmos indicates that animals when permitted to self select from 2 or more diets were offered that differed in concentration of protein, animals were able to self-select the desired concentration of protein without affecting energy intake. Even though Rosmos teaches a protein-based study to extend the concept of self-selection to other macronutrients also would have been obvious, based on the WO patent offering varying protein and fat contents.

Therefore, if the food containing the varying macronutrient contents, carbohydrate, fat and protein contents as shown by the primary references were to be offered in a free-choice feeding method so that the dogs/cats are able to self-select their diet then it can be reasonably expected that they would be driven by their nutrient intake/requirement, as disclosed by Rosmos. The reference of Wills teaches that cats

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often detect nutritional deficiencies in their diets and have the ability to reject such diets, thus showing that animals opt for diets that are complete in the nutrients they need and would have been capable of self-regulating their diets based on nutrient content, which can reasonably be expected to mean that their self-selection would be based on their innate requirement for optimal nutrients. The reference of Rice shows that “free-choice” feeding of dogs was a known method of feeding dogs *to prevent obesity and overeating*. When such teachings are taken with Rosmos, who states: “It is well established that animals, including dogs, are able to regulate their intake of energy. When the energy density of the diet is lowered, dogs consume more food to maintain approximately the same energy intake”, then for all these benefits, including preventing obesity, self-selection would have been the process of choice.

The JP patent describes separately packaging or a single packaging of more than one type of food for a cat that can be consumed either in 1 day or as one meal. The food can be dried or not and can be 5 or more different types of food. The pet foods are provided as main meals and side dishes. Note that the examples show placing the variety of foods for cats and allowing the cats to make their choice. Based on palatability the example finds that the “optimal food dish” selected was fish over seaweed and shrimp, thus increasing its appetite for the foods offered. Such disclosure shows that the animal has the ability to select the optimal type of food for itself, that offering a variety of different types of foods was already being practiced in the art and taken with the above references that also show such a concept of a variety of foods being offered, it would have been obvious to formulate a composition of a variety of

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foods with different amounts of macronutrients based on the fact that the animal has the ability based on Wills, Rosmos, Rice and the JP patent disclosure taken together, to feed itself the preferred macronutrient at its optimal level.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 3-8, 10-11 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 8 of U.S. Patent No. 10/540095 in view of Rosmos et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application is drawn to "providing" multi-component foodstuff, "allowing" the dog to eat, and basing the dog's selection upon the protein content of the food, the '095 also claims "providing" different compositions of food, wherein the animal selects the food and "allowing" the animal to consume the food and determining the amounts of nutrients consumed. While the '095 application does not claim the dog's selection on protein

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content of the food, Rosmos et al. teach that animals when permitted to self select from 2 or more diets that were offered and that differed in concentration of protein, animals were able to self-select the desired concentration of protein without affecting energy intake, rendering obvious the instant claims in view of the '095 application.

Response to Arguments

Applicant's arguments filed 7/8/2010 have been fully considered but they are not persuasive.

WO '630 has been characterized as being directed to a dietary regime with one food being fed as a morning meal and another as an afternoon/evening meal. Nonetheless, the reference teaches the pet food compositions with varying fat and protein contents as claimed herein and pointed to by applicant at page 5, remarks, and the reference teaches multi-packs with individual packs being packaged as claimed herein. Although these foods are offered in rotation, selectivity of these diets with varying amounts of protein and fat was still based on macronutrient preference. Such a teaching has been combined with the teachings of the other references applied. Applicant appears to have considered each reference separately although the rejection is under 35 USC 103 and it is the combined teachings that need to be considered. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Jewell points to the macronutrient content of animal food, particularly carbohydrate.

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Based on the WO patent and the Rosmos disclosure, it would have been obvious to vary the carbohydrate content in much the same way as the protein and fat contents as in the WO patent. It is noted that applicant has criticized the WO patent for teaching the variation of macronutrients in the morning and evening meals and has criticized Rosmos for varying only the protein content. However, it is well established that "the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). If the WO patent teaches varying the protein and fat content of an animal's food and discloses the amounts, and also teaches varying the carbohydrate content, and if Rosmos teaches varying protein content and teaches that the animal was capable of beneficially self-selecting the protein-varied foods according to its needs, and if Jewell teaches the amount of carbohydrate in a pet food, then collectively, these references render obvious 1) varying the carbohydrate content of food also based on the amounts needed by the animal and 2) allowing the animal freely choose its food from the foods that have been varied as to its macronutrient contents, so that the animal can choose its needed amounts of macronutrient. Rice has been used to show that free-choice feeding is beneficial in maintaining the weight of the animal. Applicant states that rice only shows one type of food, however, Rice is not the only reference in the combination and 35 USC 103 instructs that the references must be considered "taken as a whole". Nevertheless, Rice renders obvious the concept of free-choice feeding to the extent an excess quantity of food is placed for the animal and it selects the amounts it eats when it needs it. As for the Wills reference, applicant's remarks pointing to parts of the Wills

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reference that teach feeding dogs with “good enough” appetites or that low protein diets are rejected because of their unpalatability and the conclusion that Wills teaches that the owner supply “one pet food product per meal” cannot be used as the reason for allowance because Wills teaches at page 46, the following:

“Furthermore, cats can often detect and may reject diets that are deficient in certain nutrients, so it is important that any diet offered is nutritionally complete.”

Furthermore, the self-selection of cats rejecting one type of food over accepting certain nutrient-containing foods only establishes that animals are able to self-select foods that satisfy their nutrient needs.

With regard to Rosmos, applicant states that:

“Romsos describes a study that was done to determine if dogs are able to regulate protein intake independently of energy intake, as it is known that dogs are able to regulate their intake of energy.”

Thus, applicant admittedly states the same position as taken here, which is, that an animal self selects its food depending on its macronutrient preference, because energy is interpreted as being provided by protein, fat and carbohydrate, all the 3 macronutrients. If Rosmos discloses such a finding for protein, it is the position of the examiner that the same can reasonably be expected for the other 2 macronutrients.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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/C. SAYALA/

Primary Examiner, Art Unit 1794